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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHOWDHURY, NIGAR				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

09/889,016

**Applicant(s)**

HATANAKA ET AL.

**Examiner**

NIGAR CHOWDHURY

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-15, 17-30 and 39-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15, 17-30 and 39-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10, 12-15, 17-30, 39-66 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim(s) 22-30, 40, 53, 57, 65 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 22-30, 40, 53, 57, 65 are drawn to functional descriptive material recorded on a computer-readable-medium. Normally, the claim would be statutory. However, the specification,

at page 80 defines the claimed computer readable medium as encompassing statutory media such as a "ROM", "hard drive", "optical drive", etc, as well as ***non-statutory*** subject matter such as a "signal".

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4, 8, 12, 13, 18, 22, 23, 27, 39-44, 48 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,442,570 by Wu.
2. Regarding **claim 1**, a personal computer having a function to transfer a subset of a plurality of pieces of content data to a portable media player connected to the personal computer comprising:

- means for storing the plurality of pieces of content data to a storage medium (fig. 1-2, col. 3 lines 60-col. 4 lines 16, col. 5 lines 46-61, col. 10 lines 57-col. 11 lines 20);
- means for receiving an input selecting whether the personal computer automatically transfers the subset of the plurality of pieces of content data stored in said storage medium to the portable media player via a direct local connection for storage at the portable media player (fig. 1-2, col. 3 lines 60-col. 4 lines 16, col. 5 lines 46-61, col. 10 lines 57-col. 11 lines 20);  
and
- means for automatically transferring the subset of the plurality of pieces of content data stored in the storage medium to the connected portable media player via the direct local connection without regard to a user input designating the subset of the plurality of pieces of content data when the input received at the means for receiving an input is to automatically transfer the subset of the plurality of pieces of content data stored in said storage medium to the portable media player via the direct local connection for storage at the portable media player (fig. 1-2, col. 3 lines 60-col. 4 lines 16, col. 5 lines 46-61, col. 10 lines 57-col. 11 lines 20).

3. Regarding **claim 2**, the personal computer, further comprising:

- means for reading the subset of the plurality of pieces of content data from a recording medium (fig. 1-2, col. 3 lines 60-col. 4 lines 16, col. 5 lines 46-61, col. 7 lines 8-44, col. 10 lines 57-col. 11 lines 20),
- wherein the means for storing stores the subset of the plurality of pieces of content data read from the recording medium (fig. 1-2, col. 3 lines 60-col. 4 lines 16, col. 5 lines 46-61, col. 7 lines 8-44, col. 10 lines 57-col. 11 lines 20).

4. Regarding **claim 3**, the personal computer wherein the recording medium is an optical disc, and the means for reading reads the subset of the plurality of pieces of content data from the optical disc (col. 7 lines 8-44).

5. Regarding **claim 4**, the personal computer wherein the recording medium is a semiconductor memory, and the means for reading reads the subset of the plurality of pieces of content data from the semiconductor memory (col. 7 lines 8-44).

6. Regarding **claim 8**, the personal computer further comprising:
- means for receiving content data via a network (col. 5 lines 46-62),
  - wherein the means for storing stores the received content data as the subset of the plurality of pieces of content data (col. 5 lines 46-62).

7. **Claim 12** is rejected for the same reason as discussed in the corresponding claim 1 above.
8. **Claim 13** is rejected for the same reason as discussed in the corresponding claim 2 above.
9. **Claim 18** is rejected for the same reason as discussed in the corresponding claim 8 above.
10. **Claim 22** is rejected for the same reason as discussed in the corresponding claim 1 above.
11. **Claim 23** is rejected for the same reason as discussed in the corresponding claim 2 above.
12. **Claim 27** is rejected for the same reason as discussed in the corresponding claim 8 above.
13. **Claim 39** is rejected for the same reason as discussed in the corresponding claim 1 above.
14. **Claim 40** is rejected for the same reason as discussed in the corresponding claim 1 above.
15. **Claim 41** is rejected for the same reason as discussed in the corresponding claim 1 above.
16. **Claim 42** is rejected for the same reason as discussed in the corresponding claim 2 above.
17. **Claim 43** is rejected for the same reason as discussed in the corresponding claim 3 above.

18. **Claim 44** is rejected for the same reason as discussed in the corresponding claim 4 above.

19. **Claim 48** is rejected for the same reason as discussed in the corresponding claim 8 above.

20. Claims 5-7, 9-10, 14-15, 17, 19-21, 24-26, 28-30, 45-47, 49-50, 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,442,570 by Wu in view of US Patent No.6,931,531 by Takahashi.

21. Regarding **claim 5**, Wu discloses transferring the subset of the plurality of pieces of content data stored in the storage medium to the connected portable media player but fails to disclose the personal computer further comprising:

- means for encrypting, by a predetermined method, the subset of the plurality of pieces of content data read by the reading means,
- wherein the storage means for storing stores the encrypted subset of the plurality of pieces of content data to the storage medium.

Takahashi discloses the personal computer further comprising:

- means for encrypting, by a predetermined method, the subset of the plurality of pieces of content data read by the reading means (col. 9 lines 52-col. 12 lines 28).,
- wherein the storage means for storing stores the encrypted subset of the plurality of pieces of content data to the storage medium. (col. 9 lines 52-col. 12 lines 28).



It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed Wu's system to include a encryption unit, as taught by Takahashi, to store secure information in a storage medium.

22. Regarding **claim 6**, Wu discloses transferring the subset of the plurality of pieces of content data stored in the storage medium to the connected portable media player but fails to disclose the apparatus personal computer further comprising

- means for compressing the subset of the plurality of pieces of content data read by the means for reading in a predetermined format file,
- wherein the means for storing stores the subset of the plurality of pieces of content data compressed by the means for compressing to the storage medium.

Takahashi discloses the apparatus personal computer further comprising

- means for compressing the subset of the plurality of pieces of content data read by the means for reading in a predetermined format file (col. 9 lines 52-col. 12 lines 28),
- wherein the means for storing stores the subset of the plurality of pieces of content data compressed by the means for compressing to the storage medium (col. 9 lines 52-col. 12 lines 28).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed Wu's system to include a compression unit,

as taught by Takahashi, for storing more information in a storage medium as compressed form.

23. **Claim 7** is rejected for the same reason as discussed in the corresponding claims 5 and 6 above.

24. **Claim 9** is rejected for the same reason as discussed in the corresponding claim 5 above.

25. **Claim 10** is rejected for the same reason as discussed in the corresponding claim 6 above.

26. **Claim 14** is rejected for the same reason as discussed in the corresponding claim 5 above.

27. **Claim 15** is rejected for the same reason as discussed in the corresponding claim 6 above.

28. **Claim 17** is rejected for the same reason as discussed in the corresponding claim 7 above.

29. **Claim 19** is rejected for the same reason as discussed in the corresponding claim 9 above.

30. **Claim 20** is rejected for the same reason as discussed in the corresponding claim 10 above.

31. **Claim 21** is rejected for the same reason as discussed in the corresponding claim 11 above.

32. **Claim 24** is rejected for the same reason as discussed in the corresponding claim 5 above.
33. **Claim 25** is rejected for the same reason as discussed in the corresponding claim 6 above.
34. **Claim 26** is rejected for the same reason as discussed in the corresponding claim 7 above.
35. **Claim 28** is rejected for the same reason as discussed in the corresponding claim 9 above.
36. **Claim 29** is rejected for the same reason as discussed in the corresponding claim 10 above.
37. **Claim 30** is rejected for the same reason as discussed in the corresponding claim 11 above.
38. **Claim 45** is rejected for the same reason as discussed in the corresponding claim 5 above.
39. **Claim 46** is rejected for the same reason as discussed in the corresponding claim 6 above.
40. **Claim 47** is rejected for the same reason as discussed in the corresponding claim 5 above.
41. **Claim 49** is rejected for the same reason as discussed in the corresponding claim 5 above.
42. **Claim 50** is rejected for the same reason as discussed in the corresponding claim 6 above.

43. **Claim 63** is rejected for the same reason as discussed in the corresponding claim 6 above.

44. **Claim 64** is rejected for the same reason as discussed in the corresponding claim 6 above.

45. **Claim 65** is rejected for the same reason as discussed in the corresponding claim 6 above.

46. **Claim 66** is rejected for the same reason as discussed in the corresponding claim 6 above.

47. Claims 51-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,442,570 by Wu

48. Regarding **claim 51**, Wu discloses transferring the subset of the plurality of pieces of content data stored in the storage medium to the connected portable media player but fail to disclose the apparatus further comprising display means for displaying a bar showing progress of storing the content data by the storage means

It is noted that the use of progress bar is old and well-known in the recording art. Therefore, official notice is taken. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a well-known progress bar which will make it easier and convenient for a viewer to understand.

49. **Claim 52** is rejected for the same reason as discussed in the corresponding claim 51 above.

50. **Claim 53** is rejected for the same reason as discussed in the corresponding claim 51 above.

51. **Claim 54** is rejected for the same reason as discussed in the corresponding claim 51 above.

52. Regarding **claim 55**, Wu discloses transferring the subset of the plurality of pieces of content data stored in the storage medium to the connected portable media player but fail to disclose the information processing apparatus further comprising display means for displaying a bar in a color which shows progress of storing the content data and displaying another bar in another color which shows progress of transferring the content data stored in storage medium by the transferring means, wherein bar and the another bar are displayed so as to overlap each other

It is noted that the use of progress bar is old and well-known in the recording art. Therefore, official notice is taken. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a well-known progress bar in different colors to make it easier for a viewer to understand

53. **Claim 56** is rejected for the same reason as discussed in the corresponding claim 55 above.

54. **Claim 57** is rejected for the same reason as discussed in the corresponding claim 55 above.

55. **Claim 58** is rejected for the same reason as discussed in the corresponding claim 55 above.

56. **Claim 59** is rejected for the same reason as discussed in the corresponding claim 51 above.

57. **Claim 60** is rejected for the same reason as discussed in the corresponding claim 51 above.

58. **Claim 61** is rejected for the same reason as discussed in the corresponding claim 51 above.

59. **Claim 62** is rejected for the same reason as discussed in the corresponding claim 51 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) US 2002/0048448

b) US 5,446,714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NC  
07/01/2010

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